

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed October 27, 2005 ("Office Action"). At the time of the Office Action, Claims 1-16 were pending in the Application. In the Office Action, the Examiner withdraws Claims 12, 14, and 16; and rejects Claims 1-11, 13, and 15. Applicant amends Claims 1, 8-10, 13, and 15 and cancels Claim 2. Applicant adds new Claims 17-24. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

**Rejections Under 35 U.S.C. § 102**

The Office Action rejects Claims 1, 4, 13, and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,367,670 issued to Ward et al. ("Ward"). Applicant respectfully traverses these rejections for the reasons discussed below.

Independent Claim 1, as amended, recites:

A method for generating an audio alert, comprising:  
detecting an alert condition;  
determining a multi-tiered notification path associated with the alert condition, each tier of the notification path identifying one or more users assigned a level of responsibility with respect to the alert condition;  
constructing an audio notification message based on at least one parameter associated with the alert condition; and  
outputting the audio notification message via at least one tier of the multi-tiered notification path.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether considered

alone or in combination with any other cited references, *Ward* does not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicant respectfully submits that *Ward* does not disclose, teach, or suggest “determining a multi-tiered notification path associated with the alert condition, each tier of the notification path identifying one or more users assigned a level of responsibility with respect to the alert condition,” as recited in Claim 1. *Ward* merely discloses a system manager that “transparently monitors signals transferred between computer system components along a system bus and stores objects related to the monitored signals in an object space . . . [such that] the object space can be updated and the updated object space used to provide updated information regarding the operating conditions of the system.” (Abstract). With respect to the issuance of an alert, *Ward* discloses that “it must be determined if the alert should be delivered “in-band” or “out-of-band”.” (Column 7, lines 28-29). Generally, “an in-band alert will be transmitted by the system manager device driver 16 to the network operating system 14 which, under the control of the network management agent 15, will direct the in-band alert to a local network manager console 35 connected to the network operating system 14 by in-band network bus 42.” (Column 4, lines 15-22). “Out-of-band alerts generated by the network operating system 14, on the other hand, will be transmitted by the system manager 22 for transmission to a remotely located system manager facility 34 connected to the system manager 22 via an asynchronous link 40, for example, a telephone connection.” (Column 4, lines 22-28). Thus, *Ward* merely discloses that in band alerts and out-of-band alerts are directed to different networks elements (i.e., the local network manager console 35 and the remotely located system manager facility 34, respectively) based on whether the element generating the alert is in-band or out-of-band. With respect to the paths that are available for an out-of-band alert, *Ward* discloses “a modem/asynchronous interface 60 [that] represents the two paths along which an out-of-band alert may be transmitted, via an asynchronous communication port or via a modem, in the event that an alert condition has been established.” (Column 8, line 64 through Column 9, line 1). However, *Ward* does not disclose, teach, or suggest “determining a multi-tiered notification path associated with the alert condition, each tier of the notification path

identifying one or more users assigned a level of responsibility with respect to the alert condition,” as recited in Claim 1.

For similar reasons to those discussed above, Applicant respectfully submits that *Ward* also does not disclose, teach, or suggest “outputting the audio notification message via at least one tier of the multi-tiered notification path,” as recited in Applicant’s Claim 1. As described above, *Ward* merely discloses that in band alerts and out-of-band alerts are directed to different networks elements based on whether the element generating the alert is in-band or out-of-band. Since *Ward* does not disclose, in any manner, a multi-tiered notification path, *Ward* also cannot be said to disclose, teach, or suggest “outputting the audio notification message via at least one tier of the multi-tiered notification path,” as recited in Applicant’s Claim 1.

For at least these reasons Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claim 4 which depends from Claim 1.

The Examiner also relies on *Ward* to reject independent Claims 13 and 15. Applicant respectfully submits, however, that *Ward* does not disclose, teach, or suggest each and every element of Applicant’s independent Claims 13 and 15. For example, Claim 13 recites “means for determining a multi-tiered notification path associated with the alert condition, each tier of the notification path identifying one or more users assigned a level of responsibility with respect to the alert condition” and “means for outputting the audio notification message via at least one tier of the multi-tiered notification path.” As another example, Claim 15 recites a “computer readable instructions for determining a multi-tiered notification path associated with the alert condition, each tier of the notification path identifying one or more users assigned a level of responsibility with respect to the alert condition” and “computer readable instructions for outputting the audio notification message via at least one tier of the multi-tiered notification path.” Thus, for reasons similar to those discussed above with regard to Claim 1, Applicant respectfully submits that *Ward* does not disclose, teach, or suggest each and every element set forth in Applicant’s independent

Claims 13 and 15. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 13 and 15.

**Rejections Under 35 U.S.C. § 103**

The Office Action rejects Claims 2-3 and 5-11 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *Ward* with U.S. Patent No. 4,881,197 issued to Fischer (“*Fischer*”), U.S. Patent No. 6,073,099 issued to Sabourin et al. (“*Sabourin*”), U.S. Patent No. 6,421,707 issued to Miller et al. (“*Miller*”), U.S. Patent Application Publication No. 2001/0044840 issued to Carleton (“*Carleton*”), and U.S. Patent No. 6,161,082 issued to Goldberg et al. (“*Goldberg*”). The Office Action rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Ward* and *Fischer* in view of Official Notice (“*Official Notice*”).

First, dependent Claims 2-3 and 5-11 depend upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claims 2-3 and 5-11 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 2-3 and 5-11 include the limitations of independent Claim 1. Since Claims 2-3 and 5-11 incorporate the limitations of independent Claim 1, Applicant has not provided detailed arguments with respect to Claims 2-3 and 5-11. However, Applicant remains ready to do so if it becomes appropriate. Applicant respectfully requests reconsideration and allowance of Claims 2-3 and 5-11.

Second, Applicant respectfully submits that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Ward* with the proposed references. The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of

ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.<sup>1</sup> According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* *Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”* *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (*holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine*); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

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<sup>1</sup> Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*" M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

With regard to each proposed combination, the Examiner provides a conclusory statement as to why one of ordinary skill in the art would have been motivated to make the proposed combination. For example, with regard to independent Claims 2, 5, and 6, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of *Ward* and *Fischer* because *Fischer's* teaching of defining audio characteristics would increase the user's flexibility of *Ward*'s system by allowing a user with a flexible and efficient mechanism for simultaneously utilizing the highlighting features distinctive to each particular device on which the document or message is displayed or produced (Col. 4, lines 3-7)." (Office Action, page 4). It appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Fischer* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has touted an advantage of *Fischer* (i.e., increasing user flexibility), the Examiner has not pointed to any portion(s) of the either reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to the document composition system using named formats and named fonts of *Fischer* into the computer system manager disclosed in *Ward*. In other words, the alleged advantage of the system disclosed in *Fischer* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Fischer*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claims 2, 5, and 6. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the computer system manager disclosed in *Ward* with document composition system disclosed in *Fischer* in the manner proposed by the Examiner.<sup>2</sup> As described above, *Ward* relates to a computer system manager that “transparently monitors signals transferred between computer system components along a system bus and stores objects related to the monitored signals in an object space” such that “the object space can be updated and the updated object space used to provide updated information regarding the operating conditions of the system.” (*Ward*, Abstract). By contrast, *Fischer* relates to “[a]n interactive data processing implemented method and apparatus for composing and editing a document in which a user is afforded great flexibility in defining the document geometry and in changing the data presentation characteristics associated with non-contiguous portions of the document.” (*Fischer*, Abstract). Indeed, Applicant finds no reason in either *Ward* or *Fischer* as to why one of ordinary skill in the art would be motivated to combine these two seemingly unrelated references in the manner proposed by the Examiner for the reasons proposed by the Examiner. The identified differences in *Ward* and *Fischer* provide further evidence that one of ordinary skill in the art at the time of Applicant’s invention would have considered the references as relating to different fields of invention and would not have made the proposed combination. Applicant respectfully submits that the Examiner’s attempt to modify or combine *Ward* with *Fischer* appears to constitute the type of impermissible hindsight reconstruction of Applicant’s claims, using Applicant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For similar reasons, Applicant submits that the combinations of *Ward* with *Sabourin*, *Miller*, *Carleton*, and *Goldberg* are also improper. With respect to each combination, the Examiner has merely provided conclusory statements that do not amount to evidence as required by the M.P.E.P. In each instance, the Examiner has merely proposed an alleged

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<sup>2</sup> If “common knowledge” or “well known” art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

advantage of combining *Ward* with the respective reference (advantages which Applicant does not admit could even be achieved by combining these references in the manners the Examiner proposes). The Examiner has not pointed to any portion(s) of the either reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to modify the computer system manager disclosed in *Ward* to include the features disclosed in *Sabourin, Miller, Carleton, and Goldberg*. Instead, the Examiner has pieced together disjointed portions of non-analogous reference in an effort to meet the limitations of Applicant's claims.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Ward* with *Fischer, Sabourin, Miller, Carleton, and Goldberg* in the manners the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

Regarding Claim 7, Applicant notes the Examiner's taking of Official Notice and respectfully traverses the rejection of the claims on this basis. To the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons Applicant respectfully requests reconsideration and allowance of Claims 2-3 and 5-11.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons and other apparent reasons, Applicant respectfully requests full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant encloses a check in the amount of \$50.00 for an additional claim. Applicant believes no other fees are due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge said fees to Deposit Account No. 02-0384.

Respectfully submitted,

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